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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/604,083      | 06/27/2000  | Steven M. Bessette   | 45112-077           | 4331             |

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EXAMINER

FLOOD, MICHELE C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1654     | 18           |

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                 |   |  |
|---|-----------------|---|--|
| <b>Office Action Summary</b>  | Application No. | <b>09/604,083</b>   |  |
|   | Applicant(s)    | <b>Bessette</b>   |  |
|   | Examiner        | <b>Michele Flood</b>  |  |
|   | Art Unit        | <b>1654</b>   |  |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>  |                 |   |  |
| <b>Period for Reply</b>   |                 |   |  |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  |                 |   |  |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                 |   |  |
| <b>Status</b>   |                 |   |  |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>May 19, 2003</u>  |                 |   |  |
| 2a) <input checked="" type="checkbox"/> This action is <b>FINAL</b> .      2b) <input type="checkbox"/> This action is non-final.   |                 |   |  |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.   |                 |   |  |
| <b>Disposition of Claims</b>  |                 |   |  |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>1, 2, and 8</u> is/are pending in the application.   |                 |   |  |
| 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.   |                 |   |  |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed.  |                 |   |  |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>1, 2, and 8</u> is/are rejected.   |                 |   |  |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to.  |                 |   |  |
| 8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.  |                 |   |  |
| <b>Application Papers</b>   |                 |   |  |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner.   |                 |   |  |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.<br>Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).   |                 |   |  |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.<br>If approved, corrected drawings are required in reply to this Office action.   |                 |   |  |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.  |                 |   |  |
| <b>Priority under 35 U.S.C. §§ 119 and 120</b>  |                 |   |  |
| 13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).<br>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:<br>1. <input type="checkbox"/> Certified copies of the priority documents have been received.<br>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.<br>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).<br>*See the attached detailed Office action for a list of the certified copies not received.   |                 |   |  |
| 14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).<br>a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.   |                 |   |  |
| 15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.  |                 |   |  |
| <b>Attachment(s)</b>  |                 |   |  |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  |                 | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  |                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____   |                 | 6) <input type="checkbox"/> Other: _____                                    |  |

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## DETAILED ACTION

Acknowledgment is made of the receipt and entry of the amendment filed on May 19, 2003.

**Claims 1, 2 and 8 are under examination.**

### *Response to Arguments*

Applicant's arguments have been fully considered but they are not persuasive.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Claims 1 and 2 as amended remain rejected under 35 U.S.C. 102(b) as being anticipated by Morita (N) and Friedman et al. (A). The rejection stands for the reasons set forth in the previous Office action and for the reasons set forth below.

With regard to the teachings of Morita (JP 04059703), Applicant argues "that the disclosed compounds in Morita are merely selected on a basis of repellency of mites." However, Applicant's arguments are not persuasive because Morita teaches a miticidal composition comprising carvone, p- methyl acetophenone, 2-phenylethyl alcohol, (iso)thymol, methyl benzoate and/or methyl salicylate in the form of emulsions, dispersions, oil preparations, dusts, tablets or

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propellants. As the claim-designated composition only requires an acceptable carrier and at least one plant essential oil compound selected from the group consisting of phenyl ethyl alcohol and phenyl ethyl propionate and a pesticidally effective amount of said plant essential oil compound, the composition taught by Morita anticipates the claimed subject matter, even though Morita does not teach that the composition has the same purpose as instantly claimed by Applicant. Moreover, Morita expressly teaches that the claim-designated compound, namely 2-phenylethyl alcohol, is “added to conventional additives at ratio of 3-10 (3-5) wt. %”; and that treating filter papers with the referenced composition in a mite test procedure was as follows: “Death rate after 24 hrs. was 98.9-100%.”

Applicant argues that Friedman fails to anticipate the claimed composition because “The claimed pesticidal composition further requires a pesticidally effective amount of a compound that has been *selected on a basis of toxicity against mold mites*”; and, “Rather, the claimed invention stems from the discovery that certain compounds can be selected for their superior toxic effects against mold mites in comparison to other plant essential oil compounds (e.g., trans-anethole and benzyl alcohol).” Applicant also argues case law. However, Applicant’s arguments are neither persuasive nor commensurate in scope to the limitations of the claimed invention because Friedman teaches food product compositions comprising effective dose amounts of aromatic alcohols for the control of microbial growth including bacteria, molds and yeasts, and the growth and reproduction of mite infestation, such as that caused by the mold mite, i.e., (*Tyrophagus putrescentiae*). See Column 13, under “EXAMPLE 10”. Friedman teaches that the level of

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aromatic alcohols comprising the composition is from about 0.15 to about 1.0%, or 0.15 to about 1.5%, or 0.75 to about 1.25%, or 0.1 to about 0.75%, or 0.75 to 1% based on the weight of the food and other physiologically parameters (see Column 6, lines 12-33). Aromatic alcohols, such as the claimed phenyl ethyl alcohol, can be used alone as the effective active agent in the compositions taught by Friedman. Friedman also teaches that phenyl ethyl alcohol can be combined with an acceptable carrier, such as a food product. For instance, in Column 9, under "EXAMPLE 2", Friedman teaches a food product composition comprising 2-phenylethanol or phenyl ethyl alcohol. See also "EXAMPLE 4", in Column 10. In Column 14, lines 41-55, Friedman teaches another food product comprising 2-phenylethyl alcohol. Applicant further points to Column 13, line 48-61, emphasizing lines 58-61: "The samples are considered non-stable by the presence of an average of 30 live mites per vial. After 16 weeks, all of the samples of the experiment were found to be stable." Thus, Applicant concludes that Friedman "does not teach that the disclosed compositions are toxic against mites or present in the disclosed food preservation systems in pesticidally-effective/mitotoxic amounts to obtain the pesticidal composition of the claimed invention." However, Applicant's arguments are unpersuasive because Friedman indeed teaches a pesticidal composition comprising the same amounts of phenyl ethyl alcohol as instantly claimed and disclosed by Applicant on page 7, lines 32-34 to page 8, lines 1-10; and, therefore the claimed composition is not patentably distinct from the referenced composition. Hence, the pesticidally-effective/mitotoxic effect is inherent to the composition taught by Friedman. Moreover, the mere fact that the prior art did not appreciate or disclose the

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new property described in the instant application is not a basis for patentability. Properties are inherent in a composition. "From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing." see *In re Papesch*, 315 F.2d 381, 391, 137 USPQ 43, 51 (CCPA 1963).

Therefore, each of the cited references of Morita and Friedman are deemed to anticipate the claimed subject matter.

Claims 1 and 8 as amended remain rejected under 35 U.S.C. 102(b) as being anticipated by McGovern et al. (B) and JP 85049452 (O). The rejection stands for the reasons set forth in the previous Office action and for the reasons set forth below.

Applicant argues that neither McGovern nor JP 85049452 anticipate the claimed invention because the references do not disclose that "phenyl ethyl propionate is toxic against mold mites, let alone, may be selected on the basis of its toxicity against mold mites." However, Applicant's argument is not persuasive because McGovern teaches a composition comprising phenyl ethyl propionate and eugenol (an acceptable carrier) and JP 85049452 teaches an insect catching apparatus comprising a bag of resin (an acceptable carrier) and 2-phenyl ethyl propionate. Moreover, the mere fact that the prior art did not appreciate or disclose the new property described in the instant application is not a basis for patentability. Properties are inherent in a composition. "From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing." see *In re Papesch*, 315 F.2d 381, 391, 137 USPQ

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43, 51 (CCPA 1963). Thus, in the absence of evidence to the contrary in a side by side comparison with the prior art, the instantly claimed composition is anticipated by the cited prior art compositions.

Therefore, each of the cited references of McGovern and JP 85049452 are deemed to anticipate the claimed subject matter.

**No claims are allowed.**

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***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432. The examiner can normally be reached on Monday through Friday from 7:15 am to 3:45 pm. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196 or the Supervisory Patent Examiner, Brenda Brumback whose telephone number is (703) 306-3220.

MCF

July 1, 2003



CHRISTOPHER R. TATE  
PRIMARY EXAMINER